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J.D.

**TECHNOLOGY CENTER 2100**

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In re Application of: Vassilovski, et al.	)	
Application No. 09/698,526	)	DECISION ON PETITION TO
Attorney Docket No. 990301	)	WITHDRAW HOLDING OF
Filed: April 18, 2000	)	ABANDONMENT UNDER 37 CFR
For: METHOD AND APPARATUS FOR	)	§1.181
CONFIGURATION MANAGEMENT FOR	)	
A COMPUTING DEVICE	)	

This is a decision on the petition filed September 17, 2004, under 37 CFR §1.181, and supplemental petition filed April 5, 2005, under 37 CFR §1.181, requesting Withdrawal of the Holding of Abandonment of the above-identified application.

The petition is **DENIED**.

**RECENT CASE HISTORY**

- 1) January 14, 2004, a final rejection is mailed. Three (3) month shortened statutory period for timely response commences.
- 2) April 12, 2004, an after final amendment and request for reconsideration is filed under 37 CFR §1.116.
- 3) May 5, 2004, an advisory action is mailed indicating that the request for reconsideration does not place the application in condition for allowance.
- 4) June 16, 2004, an interview summary is completed and mailed.
- 5) September 17, 2004 (bearing a certificate of mailing on May 27, 2004), a second amendment after final, response, request for reconsideration, two months extension of time and (instant) petition is filed.
- 6) March 22, 2005, a second advisory action is mailed indicating that the second amendment and response fails to place the application in condition for allowance.
- 7) Also on March 22, 2005, a notice of abandonment is mailed indicating that both replies filed April 12 and May 27, 2004, fail to place the application in condition for allowance and that the statutory period for reply has expired, thus the application is abandoned.

8) April 5, 2005, a copy of the May 27, 2004 after final amendment and response, request for continued examination (RCE), and (supplemental) petition to withdraw the holding of abandonment, is filed.

9) After filing the instant petition and RCE, the Examiner improperly prepares and mails a non-final Office action on June 30, 2005 and Applicant responds with an amendment and remarks on December 28, 2005.

### **BASIS OF OPINION**

The relevant portions of the Statutes and Rules are reproduced below. Emphasis is added to draw attention to critical phrases.

#### **§ 1.135 Abandonment for failure to reply within time period.**

(a) If an applicant of a patent application fails to reply within the time period provided under §1.134 and §1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. *The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.*

#### **§ 1.113 Final rejection or action.**

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants or patent owner's reply is *limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116.....*

(c) *Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.*

#### **§ 1.116 Amendments after final action or appeal.**

(b) After a final rejection or other final action (§ 1.113), amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. *The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings, will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.*

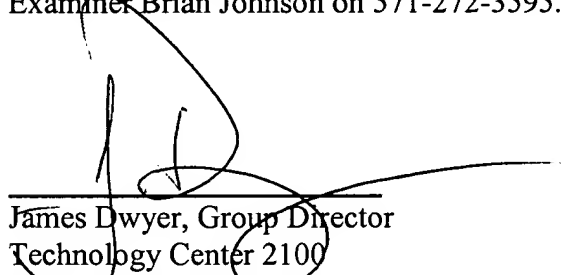
### **DECISION**

Petitioner has provided evidence to the timely response to the final Office action of January 14, 2004 in the petition (and supplement) that includes: a copy of the amendment and response to the final Office action (certificate of mailing dated May 27, 2004); amendment transmittal form with two months request for extension of time (to June 14, 2004) as well as a supplemental statement under 37 CFR § 1.8(b)(3), provided on March 13, 2006 in response to a telephone conversation with Peng Zhu (Reg. No. 48,063) on March 9, 2006.

As clearly set forth in 37 CFR §1.135, the admission of, or refusal to admit any amendment after final rejection will not operate to save the application from abandonment [emphasis added]. Irrespective of applicant's timely filing of the response of May 27, 2004 to the final office action mailed January 14, 2004, since the response was held *not* to be in compliance with 37 CFR §1.116 (discussed above) as indicated in both the advisory action of March 22, 2005 and the notice of abandonment mailed March 22, 2005, the statutory period for response to the final rejection expired on July 14, 2004. Accordingly, the case remains **abandoned in fact** for failure to timely file a proper reply under §1.116 to the final Office action.

The petition is **DENIED**. The holding of abandonment is maintained as proper. The application will be forwarded to the Supervisory Legal Instruments Examiner with instructions to **VACATE** both the non-final Office action mailed June 30, 2005 and the RCE filed April 5, 2005 and to then place the application in abandoned status.

With respect to those documents filed and actions taken after the mailing of the notice of abandonment on March 22, 2005, Applicant should note that these papers have no effect on the instant application, as no prosecution can take place in an abandoned application. Petitioner may wish to revive the application under 37 CFR §1.137 and request that the papers of record between April 5, 2005 and December 28, 2005 be re-entered and reinstated to continue prosecution from that point. Any questions regarding this decision should be directed to Special Programs Examiner Brian Johnson on 571-272-3595.



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